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In re Application of BENZ et al  
U.S. Application No.: 09/889,078  
Int. Application No.: PCT/US97/16812  
Int. Filing Date: 22 October 1997  
Priority Date: none  
Attorney Docket No.: RD-25877  
For: METHOD FOR DISSOLUTION OF  
NITROGEN-RICH INCLUSIONS IN  
TITANIUM AND TITANIUM ALLOYS

DECISION

This is in response to applicants' "Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally Under 37CFR 137(b)" and "Petition to Grant a Priority Date for a PCT Application" filed 11 July 2001. The requisite petition fees have been charged to Deposit Account No. 09-0470.

**BACKGROUND**

On 22 October 1997, applicants filed international application PCT/US97/16812. A Demand for international preliminary examination, in which the United States was elected, was filed on 15 May 1998, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 24 April 2000 (22 April 2000 was a Saturday).

International application PCT/US97/16812 became abandoned as to the United States at midnight on 24 April 2000 for failure to pay the basic national fee.

On 11 July 2001, applicants filed the present petition. The petition states that it is accompanied by a proper response under 35 U.S.C. 371 and a statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional."

## DISCUSSION

### I. Petition Under 37 CFR 1.137(b)

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

With regard to item (1), applicants have provided the required basic national fee under 35 U.S.C. 371.

With regard to item (2), the required petition fee has been charged to Deposit Account No. 09-0470 as authorized in the Transmittal Letter filed with the present petition.

With regard to item (3), applicants have provided the required statement.

With regard to item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.

Thus, applicants have satisfied all the requirements for a petition under 37 CFR 1.137(b).

### II. Petition to Grant Priority Date

PCT Article 11(1)(ii) specifies that the date of receipt of the international application shall be accorded as the International Filing Date, provided that the international application is in the prescribed language. Furthermore, PCT Rule 12 provides that an international application shall be filed in any language that the Receiving Office accepts for that purpose.

In the present case, international application PCT/US97/16812 was filed with the United States Receiving Office (RO/US). The description portion of the purported international application papers submitted on 22 September 1997 included text in the Russian language. The RO/US accepts only the English language for the filing of international application papers. Therefore, the purported international application papers submitted on 22 September 1997 are not entitled to an International Filing Date of 22 September 1997.

Applicant requests that the United States Designated/Elected Office grant a priority date of 25 September 1996 for the present U.S. national stage application. Because the claimed priority date of 25 September 1996 is not within one year of the proper International Filing Date of 22 October 1997, it would be inappropriate at the present time to grant the requested relief.

The petition states that inclusion of Russian text in the description was an obvious error within the meaning of PCT Rule 91. PCT Rule 91.1(b) states,

Errors which are due to the fact that something other than what was obviously intended was written in the international application or other paper shall be regarded as obvious errors. The rectification itself shall be obvious in the sense that anyone would immediately realize that nothing else could have been intended that what is offered as rectification.

In the present case, the proposed rectification was not obvious in the sense that anyone would immediately realize that nothing else could have been intended.

The petition further states that because the European Patent Office International Searching Authority (ISA/EP) accepts documents in the Russian language, the purported international application papers submitted on 22 September 1997 were in compliance with PCT Article 3.4(i) and PCT Article 11. However, because the RO/US does not accept international application papers filed in the Russian language, the papers submitted on 22 September 1997 were not in compliance with PCT Rule 12.1(a) and thus are not entitled to an International Filing Date of 22 September 1997.

### CONCLUSION

For the reasons set forth in §I above, the petition under 37 CFR 1.137(b) is GRANTED.

For the reasons set forth in §II above, the petition to grant a priority date is DISMISSED without prejudice.

This application has an international filing date of 22 October 1997 and a date under 35 U.S.C. 371 of 11 July 2001.

If reconsideration on the merits of this decision is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision.

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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